

## **REMARKS**

These remarks are responsive to the Office Action mailed on April 28, 2008 (“the Office Action”). The Applicants thank the Examiner for a careful and thorough examination of the above-referenced Application, as well as the indication of allowable subject matter.

## **Status of the Claims**

At the time of the Office Action, Claims 1, 3-34 and 36-48 were pending and Claims 1, 3-34 and 36-48 were rejected. Claims 2 and 35 were previously canceled.

## **Response to Examiner’s Argument**

Applicants initially respond to the Examiner’s response at page 2, section 1 of the pending office action. The Examiner continues to argue what is a reasonable definition of “biasing mechanism”. The Examiner utilizes the Franz *et al.* (U.S. 7,027,309 – hereinafter “Franz”) which indicates that a biasing mechanism [66] has a leverage member wherein the actuation of the leverage member biases a first electrical connector between engaged and disengaged positions with respect to a second electrical connector. The Examiner alleges that the teaching of Franz shows that a physical force may be placed on the biasing mechanism [66] which influences, forces, urges, or otherwise causes movement of the printed circuit board relative to the computer device.

Applicants respectfully distinguish the biasing mechanism of Franz from Hideki. The biasing member [66] includes a lever as well as arm members [96] to engaged and disengage electrical members. To equate Hideki to the teachings of Franz, the scanner assembly [1] would correspond to the printed circuit board 64 while the base portion [2]

of Hideki would correspond to the chassis [17] of Franz. The biasing mechanism [66] including lever arms [96] allow for engagement and disengagement of the circuit board [64] from the chassis [17]. However, there is no “biasing mechanism” on the Hideki device which allows for application of force, influence or urging to the scanner assembly [1]. Instead, a force is applied directly to the scanner assembly [1] in order to cause movement relative to the base [2] through the rollers and shafts alleged by the Examiner. Simply stated, Hideki fails to teach an element which urges, leverages, or forces the components to move, contrary to the biasing mechanism of Franz which applies such force or leverage to overcome resistive force in seating the electrical contacts of the circuit board and the motherboard and to lock the circuit board in position. The components of Hideki merely facilitate sliding movement but do not apply a force or leverage which is distinct from the user input force.

To further distinguish, Applicants respectfully direct the Examiner to Franz column 6, line 13, which states, “The biasing mechanism 66 may provide leverage to couple the corresponding connector 70 and 72....” Additionally, Franz teaches at column 6, line 20, “An actuation member 76 or lever of the biasing mechanism 66 is ....” The biasing mechanism 66 therefore provides a structure to which force is applied in order to move an alternative part, i.e. the printed circuit board [64]. However, Hideki fails to provide any biasing member in order to move the scanner assembly [1]. Hideki merely provides rollers and shafts, cited by the Examiner, which allow motion but do not apply any force to the scanner assembly [1]. Applicants assert that this argument is commensurate with Applicant’s previously provided argument and definition, while

distinguishing the Examiner's application and definition of the term "biasing mechanism".

### **35 U.S.C. § 103 Rejections**

The Examiner has rejected Claims 1-17, 22-23, 26-34, 36-41 and 43-48 under 35 U.S.C. §103(a) as being unpatentable over Fukuchi *et al.* (U.S. 5,126,789 – hereinafter "Fukuchi") in view of Hideki (JP 09-189972 – hereinafter "Hideki") and Goshima *et al.* (U.S. 4,192,608 – hereinafter "Goshima"). Applicants respectfully traverse these rejections.

The Examiner alleges that Fukuchi teaches various elements of the claimed invention but fails to disclose the scanner bed being slidably positioned on the base housing. The Examiner next states that Hideki teaches a scanner bed which is slidable between a first position and a second position. Additionally, the Examiner acknowledges that Hideki suggest the disadvantage of the clam shell design which is employed by Fukuchi and which necessitates additional dampening, thus increasing costs, and proposes to solve this problem by having a sliding configuration with a scanner section which slides relative to the printer section. The Examiner next alleges that it would have been obvious to one of ordinary skill in the art to modify the apparatus of Fukuchi in the configuration suggested by Hideki in order to reduce cost. The Examiner additionally recites the use of Goshima as teaching the mechanical components for implementation for one part of the apparatus moving slidably relative to the base of the apparatus.

The Examiner is reminded of the landmark Supreme Court case *KSR v. Teleflex* which requires some reasoning provided for making a combination in rendering teachings of an application obvious.

“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, ; 127 S.Ct. 1727, 1741.

In other words, an Examiner should not merely pick and choose from elements because the elements are separately known in the prior art. However, it is evident from the Examiner’s rejection that he is merely picking and choosing elements and combining them without regard to their operability or the reference teachings.

The Examiner has failed to make a prima facie showing of obviousness where: [A] the cited combination fails to show all elements of the claimed invention; [B] the cited combination renders the Fukuchi device inoperable; and, [C] the Examiner has utilized the teachings of the Applicants.

***A. Missing Element in Cited Combination***

The Examiner alleges that Hideki teaches a biasing mechanism and has argued the definition as previously discussed. Applicants maintain, as previously discussed in at least one Office Action and during a telephone interview with the Examiner, that Hideki fails to teach a biasing mechanism. The biasing mechanism of Franz, as argued by the Examiner, provides a leverage or actuation member. This leverage or actuation member is distinct from the mechanism or structure which allows the printed circuit board [64] to move relative to the chassis [70]. Similarly, Hideki teaches a plurality of structure, such as rollers and shafts, which allow movement of the scanner assembly [1] to move relative to the base [2]. However, the Hideki roller and shaft structure does not leverage or actuate the scanner assembly [1] as the leverage or actuation member of the biasing mechanism [66] taught by Franz. Accordingly, Applicants maintain that Hideki fails to

teach a biasing mechanism as required by the claim element. Instead Applicants assert that Hideki only teaches mechanisms which allow movement of the scanner relative to the base but not mechanisms to bias the scanner relative to the base.

***B. Inoperability of the Cited Combination***

Figure 31 of the Fukuchi reference teaches a clam shell scanner design which is utilized with a stationary base portion housing a printing assembly. The scanner [60] pivots at element [61] so as to raise or lower relative to the printing and base portion, generally indicated at element [10]. The Examiner alleges that the sliding function of Hideki may be combined with the Fukuchi device so as to provide a slidable scanner portion [60] which slides relative to the base printing portion [10].

In order to render a claim obvious, a combination of cited prior art references may not be modified in a way which renders the prior art devices inoperable or changes their intended use. Contrary to the Examiner's allegation, the proposed device would be inoperable. MPEP 2143 recites, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In Re Gorman*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Referring to Fukuchi, Figure 31, the pivot portion [61] is fixed between the scanner housing [60] and the base housing [10]. Lateral or sliding motion proposed by the Examiner would preclude pivoting since the pivotal connection between the upper scanner portion [60] and the lower base portion [10] would necessarily be broken by the lateral or sliding motion of the scanner portion [60] relative to the base portion [10].

Accordingly, the Examiner's proposed combination would render Fukuchi inoperable and this change the intended use of the device.

The Examiner is respectfully reminded of the discussion of *Adams* in the Supreme Court decision *KSR*, which describes, "The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." (*KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, ; 127 S.Ct. 1727, 1741 (2007), citing *U.S. v. Adams*, 383 U.S. 39 (1966)). Accordingly, where the Examiner's proposed modification would render the prior art teachings inoperable, Applicant asserts that the successful combination provided by Applicants is more likely to be nonobvious.

Additionally, while *KSR* has limited the rigid application of the teaching, suggestion, motivation (TSM) test, *KSR* indicates the TSM test may still be used as a factor in a comprehensive obviousness analysis. Applicants assert that there is no teaching, suggestion or motivation provided for making the Examiner's cited combination of Fukuchi and Hideki, apart from the Applicants' teaching. Specifically, as previously described, Hideki teaches away from the use of a clam shell scanner assembly. Fukuchi alternatively teaches a clam shell scanner assembly and accordingly, not only is there failure of teaching, suggestion, and motivation it is explicitly clear that the Hideki reference teaches away from a combination alleged by the Examiner.

Further, Applicants respectfully remind the Examiner that he [a] must consider the references for the whole of their teaching and [b] cannot simply disregard the portions of the teachings which are inconvenient to the Examiner's proposed combination. Prior art references must be considered in their entirety, i.e., as a whole, including portions that

would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Applicants assert that the Examiner cannot simply disregard the fact that the proposed modification would leave the Fukuchi device inoperable. Since the proposed combination would render at least one of the references inoperable, Applicant asserts that the Examiner's proposed combination is improper and that the Examiner has failed to make a prima facie showing of obviousness.

### ***C. Improper Hindsight Rejection***

Applicants further remind the Examiner that the Federal Circuit and the Supreme Court have warned against hindsight rejections. The Supreme Court has warned against "distortion caused by hindsight bias" and cautioned against "arguments reliant upon *ex post* reasoning." See *KSR* citing *Graham*, 383 U.S., at 36 (warning against a "temptation to read into the prior art teaching of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight." (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))). Additionally, MPEP 2142 adds, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is evident from the Examiner's proposed combination which utilizes references which render one another inoperable that the Examiner has made such hindsight rejection that the Supreme Court and the Federal Circuit have deemed improper.

The Examiner has further asserted Goshima in combination with the Hideki and Fukuchi references as providing the elements allowing the slidable motion. However, as

previously indicated, adding slidable components to the device taught in Figure 31 of Fukuchi would render the Fukuchi device inoperable and would alter its intended use. The Fukuchi device of Figure 31 utilizes a hinge structure [61] which must be connected to both the upper scanner assembly [60] and the lower base portion [10]. If the two assemblies are not laterally fixed, a hinge structure cannot operate properly. With a laterally slidable motion between the scanner assembly [60] and the base portion [10], utilizing the components of Goshima, the hinge assembly [61] would be rendered inoperable. This is in addition to the fact that the Hideki reference explicitly teaches away from a clam shell or hinge type scanner and base connection.

Accordingly, Applicants respectfully assert that the cited combination is improper since the Examiner has clearly utilized the Applicants' teachings rather than the knowledge of the prior art.

Additionally, regarding Claim 27, the Examiner has provided no reasoning for the statement that "it would have been obvious to one of ordinary skill in the art to dispose the biasing springs within said pocket and incorporate such arrangement of spring-within-pocket into the device of Hideki." Again, the Supreme Court decision of *KSR* dictates that some reasoning must be provided and that as stated previously herein, case law also requires that such reasoning must not come from the Applicant's teachings.

For at least the reasons set forth herein, the Applicants respectfully submit that the cited references fails to render obvious the independent claims, and any claim depending therefrom. Thus, the Applicants respectfully request that this rejection be withdrawn.



**Conclusion**

The Applicants respectfully submit that the application is in condition for allowance, and reconsideration and notice of allowance are respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with the Applicants' counsel, in person or over the telephone, the Applicants' counsel would welcome the opportunity to do so.

Respectfully submitted,

**MIDDLETON REUTLINGER**

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